



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,006	11/20/2003	Nobuaki Hori	ABJT-004CON5	9100
24353 7590 06/12/2007 BOZICEVIC, FIELD & FRANCIS LLP 1900 UNIVERSITY AVENUE SUITE 200 EAST PALO ALTO, CA 94303			EXAMINER TUNGATURTHI, PARITHOSH K	
			ART UNIT 1643	PAPER NUMBER
			MAIL DATE 06/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/719,006	<b>Applicant(s)</b> HORI ET AL.	
	<b>Examiner</b> Parithosh K. Tungaturthi	<b>Art Unit</b> 1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 24-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The applicant has timely traversed the non-final rejection in the reply filed on 03/21/2007, and a response to the arguments is set forth.
2. Claims 24, 25 and 29 have been amended.
3. Claims 24-38 are under examination.

### ***Rejections Withdrawn***

4. The rejection of claims 24-38 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of amendments to the claims.
5. The rejection of claims 24-38 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method for producing a human antibody, said method comprising....., does not reasonably provide enablement for producing a human antibody, said method comprising:..... is withdrawn in view of amendments to the claims.
6. The rejection of claims 24, 25, 27-32 and 34-38 under 35 U.S.C. 102(b) as being anticipated by Trill et al (Current Opinion in Biotechnology. 1995. 6:553-560; IDS – 06/22/2006) as evidenced by Orlandi et al (Proc. Natl. Acad. Sci. USA, 86:3833-3837, 1989) is withdrawn in view of applicants arguments.

Art Unit: 1643

Trill et al does not teach a method of introducing a first polynucleotide into a first mammalian myeloma cell, introducing a second polynucleotide into a second mammalian myeloma cell, culturing the mammalian myeloma cells separately in the presence of an amplification agent, and fusing the cultured cells to form a hybrid cell.

7. The provisional rejection of claims 24, 25, 29 and 30 over Claims 38-40 of copending Application No. 10/353,844 in view of Trill (Current Opinion in Biotechnology, 1995, 6:553-560; IDS – 06/22/2006) is withdrawn.

The copending Application No. 10/353,844 has been abandoned.

### ***Rejections Maintained***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1643

8. Claims 24-38 remain rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 5-8 of U.S. Patent No. 6,677,138 in view of Trill et al (Current Opinion in Biotechnology. 1995. 6:553-560; IDS – 06/22/2006) as evidenced by Orlandi et al (Proc. Natl. Acad. Sci. USA, 86:3833-3837, 1989). Further, claims 24-38 remain rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6-13 and 15-27 of U.S. Patent No. 6,420,140; over Claims 1-4 and 6-11 of U.S. Patent No. 6,207,418; over Claims 1-4 and 6-11 of U.S. Patent No. 5,916,771, all in view of Trill (Current Opinion in Biotechnology. 1995. 6:553-560; IDS – 06/22/2006).

9. Claims 24-38 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 50, 51, 56, 58-65, 67 and 69-74 of copending Application No. 10/155,839 in view of Trill (Current Opinion in Biotechnology. 1995. 6:553-560; IDS – 06/22/2006).

The applicants argue that submitting a terminal disclaimer will be considered to overcome the rejection of Claims 24-38 under the judicially created doctrine of obviousness-type double patenting once Claims 24-38 are found to be otherwise allowable.

Such arguments not found persuasive, the claims remain rejected until a terminal disclaimer is filed.

***Conclusion***

10. No claims are allowed.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Parithosh K. Tungaturthi whose telephone number is 571-272-8789. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry R. Helms, Ph.D. can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1643

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully,  
Parithosh K. Tungaturthi  
Ph: (571) 272-8789



DAVID J. BLANCHARD  
PATENT EXAMINER